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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,051	07/30/2004	Takashi Kadowaki	256653US0PCT	2505

22850	7590	11/02/2007
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314		

EXAMINER	
STOICA, ELLY GERALD	

ART UNIT	PAPER NUMBER
1647	

NOTIFICATION DATE	DELIVERY MODE
11/02/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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oblonpat@oblon.com
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Office Action Summary	Application No. 10/502,051	Applicant(s) KADOWAKI ET AL.	
	Examiner Elly-Gerald Stoica	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9,10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,9,10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the claims

1. Applicant's amendment filed 08/23/2007 cancelled claims 7, 8, 11, and 12. Claims 1-6, 9-10, and 13-16 are pending. Claims 1, 3, 5, 6, 9, and 10 be amended have been canceled. Claims 13-16 have been added. Claims 2 and 4 are withdrawn. Claims 1, 3, 5, 6, 9, 10, and 13-16 are subject to examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the word "encompasses". It is not clear if the word is used to mean "consists" or "comprises". Therefore the meets and bounds of the claims could not be determined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1,3 remain rejected and the amended claims 5, 6, 9, 10, and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Scherer et al. (U.S. Pat. 5,869,330) for the reasons of record.

At page 6, applicants argue that Scherer et al. do not disclose the c-terminal globular domain of adiponectin. This argument has been fully considered but is not deemed persuasive.

Scherer et al. teach a method of modulating the insulin production by administering Acrp30 to an individual (p 5 lines 17-21). Moreover, the authors teach the use of portions of the Acrp30 that has the same function or activity of the whole protein (p 8 line 30- p 9 line15). The Acrp30 protein taught by Scherer et al has the Seq. Id No: 7, which, according to the sequence search result available in SCORE, is IDENTICAL to SEQ. ID. NO: 2 (i.e., adiponectin) of the current application. Because the biochemical and biological properties of a protein are intrinsic to its structure, the adiponectin was clearly anticipated as well as its uses. Moreover, in the Figure 1 and in the example 1, Scherer et al. clearly indicate the C-terminal globular domain starting from amino acid residue 111.

Consequently the claims are anticipated by Scherer et al.

6. Claims 1, 3, 5, 6, 9, 10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Fruebis et al. (U.S. Pat. 6,566,332).

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Fruebis et al. teach a polypeptide, OBG3, with a sequence (Seq. Id. No.: 6)

100% identical with the polypeptide of the Sequence Id No: 2 of the instant Application:

RESULT 9

US-09-776-976-6

; Sequence 6, Application US/09776976

; Patent No. 6566332

; GENERAL INFORMATION:

; APPLICANT: Fruebis, Joachim

; APPLICANT: Erickson, Mary Ruth

; APPLICANT: Yen, Frances

; APPLICANT: Bihain, Bernard

; TITLE OF INVENTION: OBG3 Globular Head and Uses Thereof for Decreasing Body Mass

; FILE REFERENCE: 76.US4.REG

; CURRENT APPLICATION NUMBER: US/09/776,976

; CURRENT FILING DATE: 2001-02-05

; PRIOR APPLICATION NUMBER: US 09/758,055

; PRIOR FILING DATE: 2001-01-10

; PRIOR APPLICATION NUMBER: US 60/176,228

; PRIOR FILING DATE: 2000-01-14

; PRIOR APPLICATION NUMBER: US 60/198,087

; PRIOR FILING DATE: 2000-04-13

; PRIOR APPLICATION NUMBER: US 60/299,881

; PRIOR FILING DATE: 2000-09-01

; NUMBER OF SEQ ID NOS: 7

; SOFTWARE: Patent.pm

; SEQ ID NO 6

; LENGTH: 244

; TYPE: PRT

; ORGANISM: Homo sapiens

US-09-776-976-6

Query Match 100.0%; Score 1336; DB 2; Length 244;

Best Local Similarity 100.0%; Pred. No. 5.4e-128;

Matches 244; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

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Qy      1 MLLLGAVLLLLLALPGHDQETTTQGPVLLPLPKGACTGWMAGIPGHPGHNGAPGRDGRDG 60
        |||
Db      1 MLLLGAVLLLLLALPGHDQETTTQGPVLLPLPKGACTGWMAGIPGHPGHNGAPGRDGRDG 60

Qy     61 TPGEKGEKGDPLIGPKGDIGETGVPGAEGPRGFPGIQGRKGEPGEGAYVYRSAFSVGL120
        |||
Db     61 TPGEKGEKGDPLIGPKGDIGETGVPGAEGPRGFPGIQGRKGEPGEGAYVYRSAFSVGL120

Qy    121 TYVTIPNMPIRFTKIFYNQNHYDGSTGKFHCNIPGLYYFAYHITVYMKDVKVSLFKKDK180
        |||
Db    121 TYVTIPNMPIRFTKIFYNQNHYDGSTGKFHCNIPGLYYFAYHITVYMKDVKVSLFKKDK180

Qy    181 AMLFTYDQYQENNVDQASGSVLLHLEVGQVWLQVYGEGERNGLYADNDNDSTFTGFLLY240
        |||
Db    181 AMLFTYDQYQENNVDQASGSVLLHLEVGQVWLQVYGEGERNGLYADNDNDSTFTGFLLY240
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Qy	241	HDTN	244
Db	241	HDTN	244

Also taught is the carboxy terminus globular part, gOBG3 and gOBG3 polypeptide fragments are selected from amino acids 101 to 244, 108 to 244, or 132 to 244 of Seq. Id. No:6. The gOBG3 fragment is mammalian, preferably human or mouse, but most preferably human (col. 22., lines 24-50). The compounds are effective for reducing body mass and useful for treating obesity-related diseases and disorders. The obesity-related diseases or disorders envisioned to be treated by the methods of the invention include, but are not limited to, hyperlipidemia, atherosclerosis, diabetes, and hypertension (col. 1, lines 20-28). Also taught are pharmaceutical or physiologically acceptable compositions and medicaments for use in accordance with the present invention may be formulated in a conventional manner using one or more physiologically acceptable carriers comprising excipients and auxiliaries. Proper formulation is dependent upon the route of administration chosen (col. 51, lines 32-37). Therefore claims 1, 3, 5, 6, 9, 10, and 13-16 are anticipated by Fruebis et al.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 3, 5, 6, 9, 10, and 13-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10, 14-18 of copending Application No. 10/514715. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims have adiponectin as the active ingredient of the compositions and/or methods claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. No claims are allowed.

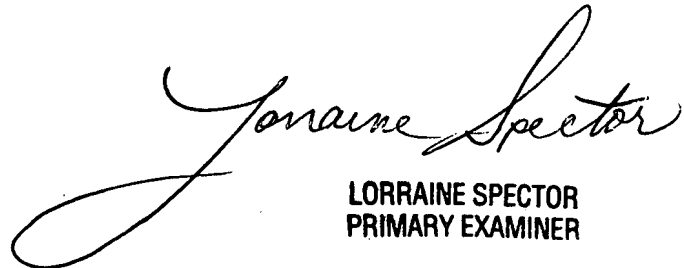
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elly-Gerald Stoica whose telephone number is (571) 272-9941. The examiner can normally be reached on 8:30-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath N. Rao can be reached on (571) 272-0939. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in cursive script, reading "Lorraine Spector". The signature is written in black ink and is positioned above the printed name and title.

**LORRAINE SPECTOR
PRIMARY EXAMINER**